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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/717,460  | 11/21/2003  | David F. Skoll       | 9-14774-IUS-I-1     | 8046             |
| 20988   | 7590        | 09/06/2005           | EXAMINER            |                  |
| OGILVY RENAULT LLP<br>1981 MCGILL COLLEGE AVENUE<br>SUITE 1600<br>MONTREAL, QC H3A2Y3<br>CANADA |             |                      | DINH, PAUL          |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2825                |                  |
| DATE MAILED: 09/06/2005   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

**Office Action Summary**

Application No.

10/717,460

Applicant(s)

SKOLL ET AL.

Examiner

Paul Dinh

Art Unit

2825

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 36-40, 79-81 and 83-87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 36-40, 79-81, 83-87 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_



### **DETAILED ACTION**

This a response to the amendment filed on 8/9/05.

Claims 36-40, 79-81, and 73-87 are pending

This application is in condition for allowance except for the following formal matters:

### ***Claim Objections***

The following claims are objected to because:

(Claims 36 and 81) features “annotation ownership tracking; unique annotation label generation; annotation locking; and annotation merging” must be clearly defined in claims 36 and claim 81 to make claims 36 and 81 complete; i.e., who owning what, tracking what, labeling what, locking what, and merging what.

(Claim 36) on line 6, the comma after the word “and” should be deleted.

(Claim 81) on line 10, the comma after the word “and” should be deleted.

(Claims 80 and 87) “the signals” lack antecedent basis and the type and the source of “the signals” must be clearly defined in claims 80 and 87; i.e., what kind of signal, signals of/from what/where.

**No new matter should be entered.**

**Correction is required.**

### ***Reasons for Allowance***

Claims 36-40, 79-81, and 73-87 would be allowable because the prior art does not teach or suggest a system/method for extracting design and layout information from a plurality of image-mosaics representative of a deconstructed IC having a combinations of all the element/steps/structures as recited in the manner as recited claims including: annotation ownership tracking; unique annotation label generation; annotation locking; and annotation merging

### ***Conclusion***

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter

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Any inquiry concerning this communication from the examiner should be directed to Paul Dinh whose telephone number is 571-272-1890. The examiner can normally be reached on Monday to Friday from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on 571-272-1907. The fax number for the organization handling this application is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Dinh  
Patent Examiner

A handwritten signature in black ink that reads "Paul Dinh". The signature is written in a cursive style with a long, sweeping underline that extends to the right.